

REMARKS

Reconsideration and allowance of the above identified patent application are hereby requested. Claims 8-18 and 20-25 are now in the application with claims 8, 16, and 25 being independent. It is noted that the application was filed without claim 19. Claims 1-7 and 26 have been withdrawn in response to the restriction requirement mailed October 9, 2007.

**Rejection Under 35 U.S.C. §103(a)**

Claims 8-18 and 20-25 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 6,006,332 to Rabne et al. in view of U.S. Patent Application Publication No. 2002/0049679 to Russell et al. and further in view of U.S. Patent Application Publication No. 2002/0198962 to Horn et al. The Office's rejections are respectfully traversed.

**CLAIM 8**

Claim 8 recites (emphasis added) "...hosting a web page including a web-based encoder object; receiving information associated with digital content at a client from the client; generating a license key for said digital content; generating a content header for said digital content; transmitting the license key and the content header to the client; and monitoring a web-based encoding and packaging of the digital content at the client by the web-based encoder object from the web-based encoder object."

The Office (Action of October 3, 2008 at page 4) asserts that Rabne et al. disclose (emphasis added)...

Generating a license key for said digital content; generating a content header for said digital content; transmitting the license key and the content header to the client; (generally disclosed in discussion of "Overview" at Column 9, line 60 – column 8, line 11 discusses access to content based on licensing agreement; also Column 7, line 10 discusses client has "ticket" [i.e. license key])

Further, the Office (*Id.* at page 3) asserts that generating a license key and a content header for digital content at a client (emphasis added) "is not a requirement of the claimed invention." The Office's assertion is incorrect and the proposed combination of Rabne et al. and Russell et al. fails to disclose the claimed subject matter.

The Office appears to read each element independently, without considering the claim as a whole. Evaluating elements in isolation is expressly prohibited by MPEP § 2146(II)(C), which states (emphasis added)...

Finally, when evaluating the scope of a claim, every limitation in the claim must be considered. USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered. See, e.g., *Diamond v. Diehr*, 450 U.S. 175, 188-89, 209 USPQ 1, 9 (1981).

Therefore, the Office must evaluate the elements including “said digital content” based on the claim as a whole.

“Said digital content” is digital content at a client. Claim 8 recites receiving information associated with digital content at a client from the client. Further, claim 8 recites generating a license key for said digital content and generating a content header for said digital content. Therefore, the Office’s (Action of October 3, 2008 at page 3) assertion that generating a license key and a content header for digital content at a client “is not a requirement of the claimed invention” is incorrect. The digital content clearly resides at the client. Accordingly, the Office’s rejection is legally and factually deficient, and withdrawal of the finality of this rejection is respectfully requested.

Moreover, Rabne et al. teach establishing permissions for content at a server, not a client. For example, Rabne et al. (Col. 6, lines 53-55) teach that (emphasis added) “The only way to access the many types of information available from the RM server is via an RMc [Rights-Manager compliant] browser application.” Rabne et al. (Col. 8, lines 6-19) also disclose that the RM server evaluates a request to view data and, if the user has permission, the RM server returns the requested holding element data and relevant permissions. Thus, Rabne et al. teach that permissions are established for content at the RM server and that both content and permissions are distributed by the RM server. Rabne et al. do not disclose generating a license key for digital content at a client. Further, Rabne et al. are silent with respect to generating a content header for digital content at a client. Russell et al. and Horn et al. also do not disclose generating a license key and a content header for said digital content. To the contrary, Horn et al. are silent with respect to license keys and Russell et al. disclose only licenses for content at a server.

Further, the Office (Action of October 3, 2008 at page 4) concedes that Rabne et al. do not disclose “monitoring a web-based encoding and packaging of the digital content at the client by the web-based encoder object from the web-based encoder object.” Nonetheless, the Office (*Id.*) asserts that Russell et al. disclose the claimed subject matter at Figures 1 and 3, and in the Abstract. The Applicant disagrees. Also, the Office (*Id.* at page 2) asserts that (emphasis added)...

...the Applicants claim does not state that the “encoding and packaging digital content is performed at the client, the claim states “monitoring a web-based encoding and packaging of the digital content at the client by the web-based encoder object from the web-based encoder object” the examiner submits that the requirement of the claim is that the monitoring is performed at the client; however encoding and packaging could be performed at any location.

The Office’s interpretation conflicts with the plain language of the claim.

Again, MPEP § 2146(II)(C) requires that the claim as a whole must be considered. Claim 8 recites (emphasis added) “monitoring a web-based encoding and packaging of the digital content at the client by the web-based encoder object from the web-based encoder object.” As discussed above, claim 8 also recites (emphasis added) “receiving information associated with digital content at a client from the client.” Thus, there can be no confusion as to where the digital content is located – it is located at the client. Because the digital content is located at the client, the recited encoding and packaging of the digital content also is performed at the client.

Russell et al. do not disclose encoding and packaging digital content at a client. To the contrary, Russell et al. teach that a client accesses digitally encoded content stored at a server. For example, Russell et al. (para. [0024]) disclose the delivery of digitally encoded motion pictures to clients through a distribution network. Further, Russell et al. (para. [0039]) disclose that digitally encoded movie files are stored on a content server for delivery to users in an encrypted form. Thus, Russell et al. do not disclose that digital content is encoded and packaged at a client. To the contrary, Russell et al. disclose that encoded/encrypted content is distributed to the requesting client.

Moreover, Russell et al. do not disclose an encoder or encoding. Thus, Russell et al. cannot disclose monitoring encoding and packaging. The Office (Action of October 3, 2008 at

page 2) asserts that (emphasis added) “Russel’s disclosure of protection against tampering is analogous to the claimed feature of ‘monitoring a web-based encoding and packaging of the digital content at the client.’” However, Russell et al. (para. [0012]) disclose that security against tampering is provided by authenticating components of the media player, security technology, and user device. Further, Russell et al. (para. [0069]) disclose (emphasis added) “...if the code within CODEC 436 had been tampered with, DRM 430 could shut down media player 440, inhibiting the viewing of movies.” Contrary to the Office’s assertion, authenticating device components and inhibiting viewing is not analogous to monitoring the encoding and packaging of digital content.

Additionally, the Office (Action of October 3, 2008 at pages 2-3) asserts that (emphasis added) “encrypted is analogous to encoded in terms if [sic] the claimed invention” and “Russell discloses a process that is network based including the usage of web servers (paragraph 36).” Nonetheless, Russell et al. fail to disclose monitoring the encoding and packaging of digital content. Russell et al. (para. [0036]) state that Fig. 1 discloses “an exemplary client-server environment...in which the secure online digital content licensing method and system may be implemented.” Further, Russell et al. (para. [0041]) disclose that the web server manages at least the search and download operations for requested content. However, downloading requested content in a client-server environment is not equivalent to monitoring a web-based encoding and packaging of the digital content.

Moreover, Fig. 3 of Russell et al. (para. [0048]) discloses a process by which a user requests a movie and a license from a server. Russell et al. (para. [0055]) further disclose that a license generated at a server is transferred to a user network-enabled device. However, generating a license also is not equivalent to monitoring a web-based encoding and packaging of the digital content. Horn et al. also do not disclose or suggest monitoring the encoding and packaging of digital content. Rather, the disclosure of Horn et al. is directed to distributing stored URLs and documents. Accordingly, the proposed combination of Rabne et al., Russell et al., and Horn et al. fails to disclose or suggest monitoring a web-based encoding and packaging of the digital content at the client by the web-based encoder object from the web-based encoder object, as recited in claim 8.

For at least these reasons, claim 8 is patentable over the proposed combination of Rabne et al. and Russell et al. Further, Horn et al. fail to cure the deficiencies of the proposed combination. Claims 9-15 depend from claim 8 and therefore are allowable at least based on claim 8.

Claim 16 includes subject matter similar to that of claim 8. Therefore, claim 16 is allowable over the proposed combination of Rabne et al. and Russell et al. for at least the reasons discussed with respect to claim 8. Further, claims 17, 18, and 20-24 depend from claim 16 and therefore are allowable at least based on claim 16.

### **Claim 10**

Claim 10 recites (emphasis added) “The method of claim 8, wherein said monitoring comprises receiving digital rights management events from the web-based encoder object during said encoding and packaging of the digital content.”

The Office (Action of October 3, 2008 at page 5) asserts that Fig. 5 of Rabne et al. discloses the claimed subject matter. The Applicant disagrees. Rabne et al. (Col. 4, lines 40-41) disclose that “Fig. 5 illustrates the RM protocol flow of an RMc browser.” Further, Rabne et al. (Col. 13, line 47-Col. ) teach that the RM protocol flow is directed to authenticating an RMc browser and controlling usage requests by the RMc browser. Rabne et al. do not disclose or suggest that either authentication or controlling usage requests occur during the encoding and packaging of digital content. Further, Fig. 5 of Rabne et al. does not disclose or suggest the web-based encoder object recited in claim 10. To the contrary, as discussed above with respect to claim 8, neither Rabne et al. nor Russell et al. disclose an encoder.

For at least these reasons, claim 10 also is allowable over the proposed combination of Rabne et al. and Russell et al. based on its own merits. Further, Horn et al. fail to cure the deficiencies of the proposed combination. Claims 11 and 12 depend from claim 10, and therefore also are allowable based on claim 10. Claim 18 includes subject matter similar to that of claim 10 and thus is allowable over the proposed combination of Rabne et al. and Russell et al. based on its own merits for at least the same reasons.

## **CLAIM 25**

Claim 25 recites (emphasis added) “An article comprising a machine-readable medium including machine-executable instructions to control a machine to: at a client, store digital content; open a web page that includes a web-based encoder object; transmit information identifying the digital content to a digital rights management server; encode the digital content; receive license information from the digital rights management server; package the encoded digital content and the license information using the web-based encoder object; and host the packaged digital content at a client server.”

The Office (Action of October 3, 2008 at page 6) asserts “Claims 16-25 are not patentably distinct from claim 8-15 and are rejected for at least the same reasons.” As discussed above with respect to claim 8, the Office (*Id.* at page 2) asserts that (emphasis added)...

...the Applicants claim does not state that the “encoding and packaging digital content is performed at the client, the claim states “monitoring a web-based encoding and packaging of the digital content at the client by the web-based encoder object from the web-based encoder object” the examiner submits that the requirement of the claim is that the monitoring is performed at the client; however encoding and packaging could be performed at any location.

The Office’s interpretation directly contradicts the express language of claim 25. Claim 25 recites “at a client, ... encode the digital content; ... package the encoded digital content and the license information using the web-based encoder object;....” As such, there can be no question that claim 25 recites encoding and packaging digital content at a client.

Russell et al. do not disclose encoding and packaging digital content at a client. To the contrary, Russell et al. teach that a client accesses digitally encoded content stored at a server. For example, Russell et al. (para. [0024]) disclose (emphasis added)...

Embodiments of the present invention address needs in the industry as described above by providing a secure digital content licensing system and method, for example enabling online rental, purchase and/or delivery of digitally encoded motion pictures. Systems and processes according to embodiments of the present invention provide a content owner or holder with a mechanism for controlling distribution of content to users by allowing users to access the content through a network.

Further, Russell et al. (para. [0039]) disclose (emphasis added)...

In one embodiment, when the user requests a movie, Web server 104 provides a URL for the location of the movie to UND [user network-enabled device] 102.

The URL directs the request to content server 106. Content server memory 108 provides storage for a large volume of digitally encoded movie files. The digitally encoded movie files that reside in content server memory 108 may be encrypted using standard encryption techniques. Content server 106 will deliver the requested movie in an encrypted form to UND 102 if the requested movie resides on content server 106.

Thus, Russell et al. teach that a content owner can control distribution of content to users. Russell et al. further disclose that digital content can be stored at and distributed from a server in an encoded and/or encrypted form. However, Russell et al. do not disclose that digital content is encoded and packaged at a client. In fact, also as discussed above, Russell et al. do not disclose an encoder.

The Office (Action of October 3, 2008 at page 4) concedes that Rabne et al. do not disclose encoding and packaging of digital content at a client. Further, Horn et al. do not disclose or suggest encoding or packaging of content. Therefore, Horn et al. do not cure the deficiencies of Rabne et al. and Russell et al. For at least these reasons, claim 25 is patentable over the proposed combination. Moreover, the Office's rejection is legally and factually deficient, and withdrawal of the finality of this rejection is respectfully requested.

Applicant : Belin Fieldson  
Serial No. : 10/734,748  
Filed : December 11, 2003  
Page : 14 of 14

Attorney's Docket No.: 15749-0002001

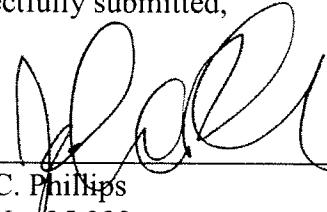
### Concluding Comments

The foregoing comments made with respect to the positions taken by the Examiner are not to be construed as acquiescence with other positions of the Examiner that have not been explicitly contested. Accordingly, the above arguments for patentability of a claim should not be construed as implying that there are not other valid reasons for patentability of that claim or other claims.

In view of the above remarks, claims 8-18 and 20-25 are in condition for allowance, and a formal notice of allowance is respectfully requested. Alternatively, withdrawal of the finality of the rejection and a new non-final rejection are respectfully requested. Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: 12/3/08

  
John C. Phillips  
Reg. No. 35,322

Fish & Richardson P.C.  
PTO Customer No. 20985  
Telephone: (858) 678-5070  
Facsimile: (877) 769-7945  
10877219.doc